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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,568	03/28/2005	Frank J Viola	2862 (203-3506)	9151

7590 02/01/2007
Paul R Audet Senior Patent & Trademark Counsel
U S Surgical a division of
Tyco Healthcare Group
150 Glover Avenue
Norwalk, CT 06856

EXAMINER

LOPEZ, MICHELLE

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/529,568	Applicant(s) VIOLA, FRANK J	
	Examiner Michelle Lopez	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-40 is/are pending in the application.
- 4a) Of the above claim(s) 28-36 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment filed on 11/16/06.

New claims 37-40 have been added.

Election/Restrictions

Newly submitted claims 38-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally elected invention of claims 17-27, i.e. Group I, and the invention of the newly submitted claims, i.e. Group II, are related as related apparatus. The Group I claims are distinct from the Group II claims in that the inventions as claimed do not overlap in scope, i.e., are mutually exclusive since the combination of the Group I claims includes a pair of jaws, first and second cam followers, and an approximation member, while the Group II claims includes a dynamic clamping member and an articulation and firing actuator. Furthermore, these mutually exclusive features of the claimed combinations are not obvious variations of each other, and the combinations are not capable of used together and have materially different operations. MPEP 806.05(j). Additionally, original claims 12-16 are evidence that the specific clamping mechanism is not required in the combination of the stapler and approximation/camming mechanism.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-27 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite in that the functional recitation of "in response to an actuating stroke" is narrative in form without positively reciting any structure. The claims should be written so that the structure is positively recited. If Applicants wish to rely on the functions of the mechanism they should be written in "means plus function" language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-27 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Plyley 5,816,471.

Plyley discloses a tool assembly comprising a pair of jaws including a first jaw and a second jaw, each of the jaws having a proximal end and a distal end, the first and second jaws being movable in relation to the other between a spaced position and an approximated position; first and second cam followers 211,212 supported on one of the first and second jaws; and an approximation member 46B including at least one cam surface 201,203 positioned to engage the first and second cam followers, the approximation member being movable to move the at least one cam surface in relation to the first and second cam followers, and to move the first jaw

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between three positions as claimed as shown in Figs. 1-3 (claim 17); wherein the first jaw includes an anvil 16 and the second jaw includes a cartridge assembly 14 (claim 18); wherein the at least one cam surface includes first and second cam channel 201,203 (claim 19); wherein the at least one cam channel includes first and second cam channels 211,217 (claim 20); wherein the approximation member includes a flat plate 46 having the at least one cam surface formed therein as shown in Fig. 5A (claim 21); wherein the first jaw includes a longitudinal slot formed in its proximal end 204 as shown in Fig. 8 (claim 22); wherein the first and second cam followers are supported on the proximal end 204 of the first jaw and extend across the longitudinal slot adjacent at least one cam surface as shown in Figs. 6 and 8 (claim 23); the first cam follower extending through the first cam channel and the second cam follower extending through the second cam channel as shown in Fig. 6 (claim 24); a body portion 17, wherein the tool assembly attached to the body portion by an articulation joint 17,18 (claim 25); wherein the body portion forms a distal end of a surgical stapling device and the proximal portion of a disposable loading unit 112 (claims 26-27); wherein the first jaw is an anvil and the second jaw is a cartridge assembly (claim 37).

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed persuasive. Applicant contends that Plyley does not teach or suggest moving the anvil portion between three positions, and does not show moving the distal end of a jaw away from another jaw and bringing the jaws together in substantially parallel closure. However, Examiner asserts that Plyley does show moving the anvil portion between three positions as shown in Figs. 1-3, and bringing the jaws together in substantially parallel closure as shown in Fig. 3.

For the reasons above the grounds of rejection are deemed proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

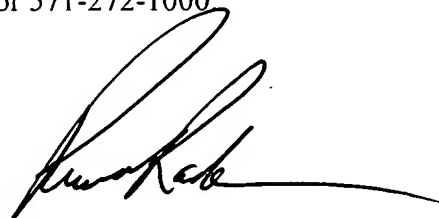
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal line extending to the right.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700